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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 12

Serial Number: 09/192,766
Filing Date: November 16, 1998
Appellant(s): Breedis et al.

Gregory S. Rosenblatt
For Appellant

EXAMINER'S ANSWER

MAILED

JUN 29 2001

This is in response to the brief on appeal filed April 16,
2001.

GROUP 1700

(1) Real Party in Interest

A statement identifying the real party in interest is
contained in the brief.

(2) Related Appeals and Interferences

The brief does not contain a statement identifying the
related appeals and interferences which will directly affect or
be directly affected by or have a bearing on the decision in the
pending appeal is contained in the brief. Therefore, it is
presumed that there are none. The Board, however, may exercise

its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

This appeal involves claims 1 and 3-12.

Claim 1 has been amended subsequent to the final rejection.

Claims 13-18 have been canceled.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The amendment after final rejection filed on January 16, 2001 has been entered.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: In issue (2), the reference no. "JP 5-912674" should be read as "JP 59-126742". The examiner has withdrawn USP 4362579 to Tsuji and JP 59-126742 references. In issue (3), references "JP5-311924" and "JP5-311925" should be read as "05-311294" and "JP05-311295" respectively.

(7) Grouping of Claims

The appealed claims 1 and 3-12 stand or fall together

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because appellant's brief does include a statement that all appealed claims do stand or fall.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

Number	Name	Date
✓ 05-311292 ✓	DOWA (Japan)	11-1993
04-354843 ✓	DOWA (Japan)	12-1992
06-184679 ✓	MITG (Japan)	07-1994
07-126779 ✓	DOWA (Japan)	05-1995
05-311294 ✓	YAMAMURA ET AL (Japan)	11-1993
05-311295 ✓	YAMAMURA ET AL (Japan)	11-1993
06-228684 ✓	SUZUKI ET AL (Japan)	08-1994
04-231430 ✓	SO ET AL (Japan)	08-1992
05-059467 ✓	TSUJI ET AL (Japan)	03-1993
06-299275 ✓	SUZUKI ET AL (Japan)	10-1994
06-179932	HATANO (Japan)	06-1994

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1, 3, and 6-12 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 5-311292 (PTO-1449, abstract and page 5, col. 7, sample No. 13 and 14), JP 4354843 (PTO-1449, abstract), JP 6184679 (PTO-1449, page 2 - [0004], or JP 7126779 (PTO-1449, page 2, col. 1).

4. Claims 1, 3-4, and 6-12 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 05311294 (abstract), JP 05311295 (abstract), or JP 06228684 (abstract).

5. Claims 1, 3-5, and 7-9 are rejected under 35 U.S.C. § 103 as being

Table 4
unpatentable over JP 04231430 (abstract), JP 05059467 (abstract), or JP 06299275
(abstract).

6. Claims 1 and 3-12 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 06179932 (abstract).

7. The cited reference(s) disclose(s) the features including the claimed Cu base alloy compositions. The features relied upon described above can be found in the reference(s) at their abstracts and Tables. The difference between the reference(s) and the claims are as follows: Some references do not disclose the claimed Ni to P ratio. it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, In re Cooper and Foley 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, Taklatwalla v. Marburg, 620 O.G. 685, 1949 C.D. 77, and In re Pilling, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those ordinary skilled in the art. In re Austin, et al., 149 USPQ 685, 688.

8. Some references may contain additional optional alloying element, but the instant transitional expression "consisting essentially of" includes the optional alloying elements from the cited references. When applicant contends that modifying components in the reference composition are excluded by the recitation of "consisting

essentially of" applicant has the burden of showing the basic and novel characteristic of his/her composition - i.e. a showing that the introduction of these components would materially change the characteristics of applicant's composition. In re De Lajarte, 337 F 2d 870, 143 USPQ 256 (CCPA 1964) and Ex parte Davis, et al., 80 USPQ 448, 450 (PTO Bd. App. 1948).

(11) Response to Argument

Appellant's arguments filed April 16, 2001 have been fully considered but they are not persuasive.

In paragraph A, appellants argue that the claimed alloy composition and Ni/P ratio of 5:1 have unexpected result. But, the claimed composition and Ni/P ratio as recited in appealed claim 1 are disclosed by JP 05311292 at col. 5, samples No. 13 and 14.

Appellants argue that JP 05311292 broadly teaches Ni/P ratio from 5:1 to 50:1. But, said reference has disclosed Ni/P ratios in col. 5, samples No. 13 and 14 with Ni/P ratios at 5.4 and 7.4 respectively.

Appellants' argument as set forth in page 6 of the instant brief, last paragraph and first paragraph of page 7 is noted. But, alloy 13 of JP 05311292 reference has shown the claimed Ni/P ratio is not critical and does not provide unexpected properties by itself.

Appellants argue that JP 05311292 does not disclose the intended use. But, the claimed intended use of the claimed alloy does not lend patentability to the alloy. A mere statement of a new use for an otherwise old or obvious composition cannot render a claim to the composition patentable. See *In re Lemin*, 51 CCPA 942, 326 F.2d 437, 140 USPQ 273 (1964), *Kropa v. Robie, Mahlman*, 88 USPQ 478 (CCPA 1951), *Ex parte Douros* 163 USPQ 667 (POBA), *In re Casey*, 152 USPQ 235 (CCPA 1967), and *In re Craige*, 188 F.2d 505, 89 USPQ 393 (CCPA 1951).

Appellants argue that JP 4-354843, JP 6-184679, JP 7-126779, JP 5-311294, JP 5-311295, JP 4-231430, JP 6-179932, and JP 6-228684 do not disclose the claimed Ni/P ratio. However, said references have Ni and P contents overlapped the claimed range. Furthermore, selecting a range in a known range by optimization for the best results is within ambit of ordinary skill artisan, see *In re Aller, et al.*, 105 USPQ 233 and *In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). Moreover, as are evident by JP5311292 samples No. 13 and 14 that the claimed Ni/P has no unexpected results. With respect to the intended use argument, the examiner reiterates the response as set forth in the paragraph immediately above.

Appellants argue that JP7-126779 and JP04231430 do not teach or suggest the claimed Cu alloy for electrical connector. The examiner disagrees. Appellants' attention is directed to titles of said references which disclose the Cu based alloy is for

multipin connectors and sockets and electroconductive material. In JP7-126779 col. 9, Tables shows 37.2 to 40.1 %IACS and JP04231430 col. 5, the Tables shows 19 to 58 %IACS, which meet the claimed greater than 25 %IACS (see appealed claim 1).

Appellants argue that Cu based alloys of JP7-126779, JP04231430, and JP 06179932 disclose many optional elements. First, the instant transitional expression "consisting essentially of" does not exclude any of those elements since appellants have not shown those elements would materially change the characteristics of appellant's composition. In re De Lajarte, 337 F 2d 870, 143 USPQ 256 (CCPA 1964) and Ex parte Davis, et al., 80 USPQ 448, 450 (PTO Bd. App. 1948). Second, the listing of numerous solutions (here elements) to a problem does not make any one solution less obvious. Ex parte Raychem Corp. 17 USPQ 2d 1417, 1424 (BPAI 1990) and Merck & Co. v. Biocraft Lab. Inc. 10 USPQ 2d 1843 (CAFC 1983).

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For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,



SIKYIN IP
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